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| 09/786,739 | 10/15/2001 | Philip George Ellis | A34093 PCT USA | 4197 |
| 21003 | 7590 | 02/27/2004 | | |
| BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | EXAMINER CRANE, DANIEL C | |
| | | | ART UNIT 3725 | PAPER NUMBER 14 |
| DATE MAILED: 02/27/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,739

Applicant(s)

ELLIS, PHILIP GEORGE

Examiner

Daniel C Crane

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003 and 06 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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NEW MATTER

The amendment filed October 22, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The insert between the second and third paragraph on page 7 of the specification where "All of the steps A-F may be performed to produce a C-section profile, and the lip rollers 45 may be driven by a hydraulic motor away from the sheet, such that only steps A-D are performed to produce a U-section profile".

Applicant is required to cancel the new matter in the reply to this Office Action.

REJECTION OF CLAIMS ON FORMAL MATTERS

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (1) Failure to provide details on the combined U-shaped channel and C-shaped channel forming operation in conjunction with the swaging of a portion of the channel with ridges renders the claimed subject matter non-enabling. In this regard, the

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disclosure does not provide adequate details on the combined operation to facilitate a clear and concise understanding of this aspect of the invention. Accordingly, the features of claim 21 and 22 are insufficiently described in the specification. (2) As to claim 23, it appears that the claim specifies features that are not originally set forth in the disclosure. The claim calls for the forming of a first and second frame member (plurality) "on the same sheet of metal strip" with the further limitation that the U-shaped channel profile (first frame member) forms a junction with the second metal frame member. It appears that the first member is separate from the second frame member or this junction is merely the merge between the U-shaped channel and the C-shaped channel "on the same sheet of metal strip". If it is the later, the claim goes beyond the original disclosure because the original disclosure does not describe a first frame member and second frame member "on the same sheet of metal strip" with a junction between the first frame member and the second frame member.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This subject matter is unclear because claim 12 calls for the forming of a first and second frame member (plurality) "on the same sheet of metal strip", however, claim 23 specifies that the U-shaped channel profile (first frame member) forms a junction with the second metal frame member. It is unclear if the first member is separate from the second frame member or

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this junction is merely the merge between the U-shaped channel and the C-shaped channel “on the same sheet of metal strip”.

REJECTION OF CLAIMS OVER PRIOR ART

Claims 12 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Laing (164,567). Laing illustrates an apparatus that involves a method of forming a “plurality of metal frame members” where the sheet material is fed through a first set of rollers to form a first member of U-shaped cross section (see Figure 2) and fed through a second set of rollers to form a second member of C-shaped section (see Figures 3 and 4). Thus, the method involves a simultaneous formation of U-shaped and C-shaped members during the operation of the apparatus “on the same sheet of metal strip”. With reference to claim 23, as the U-shaped frame member transitions into the C-shaped frame member during the forming operation, a “junction” between the two frame members is produced.

Claims 12 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer (3,462,989). See Figures 1 and 4-8 where the sheet material is fed through a series of rollers with the result being that a first frame member is formed with a U-shaped channel (see Figure 6) and a second frame member is formed with a C-shaped channel (see Figures 7 and 8). Thus, the successive forming of the sheet material establishes a “plurality” of frame members with a U-shaped channel and a C-shaped channel where the frame members are formed on the “same sheet of metal strip. With reference to claim 23, as the U-shaped frame member transitions into the C-

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shaped frame member during the forming operation, a “junction” between the two frame members is produced.

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (3,462,989) in view of Morello (5,359,871). Fischer has been treated supra. Morello discloses substantially the claimed invention where data is input into the control system of the rolling device and the control computes through a computing means the specific configuration of the channel to be produced. Morello indicates that various size and housing codes can be processed through the computing means to facilitate the production of channels used to construct building frames of predetermined size. Accordingly, it is the examiner’s position that the skilled artisan fabricating U-shaped/C-shaped panels of the type taught by Fischer having the benefit of Morello’s device would have been disposed to utilize a control system for rolled channels to properly size the channels to a particular building. Therefore, it would have been obvious to the skilled artisan to have modified Fischer’s method using Morello’s control method by using various parameters to produce the channels for a particular building.

RESPONSE TO APPLICANT’S AMENDMENT

Applicant’s response has been carefully considered, however, it is moot in light of the new grounds of rejection, such being necessitated by applicant’s amendment.

FINAL OFFICE ACTION

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

INQUIRIES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is **(703) 308-1870**. The examiner's office hours are 6:30AM-5:00PM, Tuesday through Friday. The examiner's supervisor, Mr. Allen Ostrager, can be reached at **(703) 308-3136**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1148**.

Documents related to the instant application may be submitted directly to Group 3700 by facsimile transmission at all times. Applicant(s) is(are) reminded to clearly mark any

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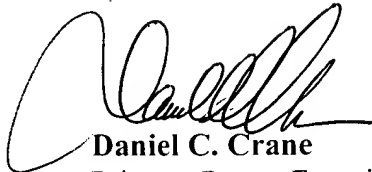
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transmission as "DRAFT" if it is not to be considered as an official response. The Group 3725

Facsimile Center number is **(703) 872-9306**.

DCCrane
February 18, 2004



Daniel C. Crane
Primary Patent Examiner
Group Art Unit 3725